

REMARKS

Claims 1-4, 6, 8, 11, and 12 are pending in the application. The Examiner's reconsideration of the rejections in view of the amendments and remarks is respectfully requested.

Claims 1-4, 6, 8, 11, and 12 have been rejected under 35 USC 101 as being directed to non-statutory subject matter. The Examiner stated essentially that the claims do not qualify as a statutory process.

Respectfully Claim 1 is a Beauregard type claim, wherein the program of instructions is structurally and functionally interrelated to the claimed computer readable medium. As such, Claim 1, and the claims dependent therefore, are believed to be tied to another statutory class.

Claims 2-4, 6, 8, 11 and 12 depend from Claim 1 and are believed to be allowable for at least the reasons given for Claim 1. Reconsideration of the rejection is respectfully requested.

Claims 1-4, 6, 8, 11, and 12 have been rejected under 35 USC 112, first paragraph, as failing to comply with the enablement requirement. The Examiner suggested that "while the specification provides one way to perform these functions, the specification does not provide a general way that would enable all potential methods of performed these functions."

Respectfully, 35 USC 112, first paragraph requires that the specification put forth a best mode. 35 USC 112, first paragraph does not require a general description "that would enable all potential methods" as suggested in the rejection. Indeed, on the basis of the specification, a rejection of the claims as broader than the enabling disclosure is not appropriate because one skilled in the art could readily determine the scope of protection sought by the claims.

Indeed, as concerns the breadth of a claim relevant to enablement, the only relevant concern should be whether the scope of enablement provided to one skilled in the art by the disclosure is commensurate with the scope of protection sought by the claims.

The Examiner concedes that “the specification provides one way to perform these functions...” Respectfully, each of the limitations noted in the rejection are supported by at least one method; on the basis of the specification, the limitations are in fact supported and meet the requirements of 35 USC 112, first paragraph. That is, the scope of protection sought by the claims would be clear to one of ordinary skill in the art.

Further, the Examiner suggests that “when a limitation encompasses any and all structures or arts for performing the recited function, including those which were not what the applicant had invented, the disclosure fails to provide a scope of enablement commensurate with the scope of the claim.” The claims must be considered as a whole; when viewed as a whole, the claims are believed to describe what the applicant has invented; that is a method of generating a feasible schedule for n jobs given a duration and a revisit time for each job. Consider that to demand that the applicant limit the claims to what has been found will work or to materials which meet the guidelines specified for “preferred” materials in a process involved would not serve the constitutional purpose of promoting progress in the useful arts; the claims are not required to be limited to a best mode. The claims meet the requirements of 35 USC 112, first paragraph when one of ordinary skill in the art would understand the scope of protection sought by the claims. One of ordinary skill in the art would understand the mathematical principles described in the specification for creating a verity of different applications capable of performing the claimed functions.

As an aside, the rejection also cites *Ex parte Miyazaki* which deals with indefiniteness based on claims amenable to two or more plausible claim constructions. The present rejection does not suggest that the present claims are amenable to two or more plausible claims constructions, therefore, *Ex parte Miyazaki* is believed to be moot in view of the present pending claims.

In view of the foregoing, the claims are believed to be sufficiently definite such that those skilled in the art would understand what is being claimed when the claim is read in light of the Specification.

Claims 2-4, 6, 8, 11 and 12 depend from Claim 1 and are believed to be allowable for at least the reasons given for Claim 1. Reconsideration of the rejection is respectfully requested.

Claims 1-4, 6, 8, 11, and 12 have been rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement. The Examiner suggested that the “applicant demonstrates possession of only one potential embodiment of the broad claim coverage. Because one embodiment does not suggest the potential other forms of algorithms that fall under the claim’s scope, one would not be conveyed of possession of an invention that covered such broad scope.”

The written description requirement is satisfied when the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed. The specification sets forth at least one embodiment which would reasonably convey to the artisan that the inventor had possession at that time of the later claimed subject matter, see for example, page 10 line 19 to page 12, line 24, and more generally, page 12, line 25 to page 16, line 10.

The Examiner’s reconsideration of the rejection is requested in view of the foregoing.

Claims 1-4, 6, 8, 11, and 12 have been rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which application regards as the invention.

The Examiner suggested re-introducing the previous-recited step of “determining... whether it is impossible to generate a feasible schedule.” The Examiner further suggested, “this step is a necessary part of the invention because the specification does not suggest that this step is optionally.”

Respectfully, a rejection based on the failure to satisfy this requirement is appropriate only where applicant has stated, somewhere other than in the application as filed, that the invention is something different from what is defined by the claims. The invention set forth in the claims must be presumed, in the absence of evidence to the contrary, to be that which applicants regard as their invention.

Further, the content of the specification is not used as evidence that the scope of the claims is inconsistent with the subject matter which applicants regard as their invention. Agreement, or lack thereof, between the claims and the specification is irrelevant to compliance with 35 USC 112, second paragraph.

Moreover, the second paragraph of 35 U.S.C. 112 does not prohibit applicants from changing what they regard as their invention during the pendency of the application.

In view of the foregoing, reconsideration of the rejection is respectfully requested.

For the forgoing reasons, the application, including Claims 1-4, 6, 8, 11, and 12, is believed to be in condition for allowance. Early and favorable reconsideration of the case is respectfully requested.

Respectfully submitted,

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